

REMARKS

Claims 1-19 were pending in the application. The Examiner has rejected Claims 1-19. Claims 1, 2, 3, 4, and 5 have been amended. No new matter was added with this change. Support for these amendments can be found on page 6, lines 14-16, for example.

1. Rejections under 35 U.S.C. § 102(b)

The Examiner rejected Claims 1, 2, 4, 5, 11, 12, 13, 15, and 16 "under 35 U.S.C. 102(b) as being anticipated by Perrine (U.S. Patent 5,803,826)." Office Action, page 2. Claims 12, 13, 15, and 16 have been cancelled. Applicant strenuously traverses this rejection of claims 1, 2, 4, 5, and 11. However, in the interest of clarity, Applicant has amended claims 1, 2, 3, 4, and 5 and requests reconsideration of these claims.

The Examiner has stated that *Perrine* discloses a "base element (14); Mark retaining surface means (12); Retaining means (column 7, lines 17-23); A rubber mat operably secured to said base element, wherein said rubber mat underlies said base element (column 6, lines 27-28)." Office Action, page 2, in pertinent part. Applicant respectfully disagrees with the Examiner's characterization of the cited reference.

With regard to claim 1, *Perrine* refers to bottom pad 14 as being "made from a relatively soft layer of foam rubber, woven fabric, etc." *Perrine*, Col. 6, lns. 27-28. *Perrine* does not disclose a "rigid support layer", as recited in claim 1 as amended. *Perrine* discloses its bottom pad, in its firmest embodiment, as being "either a low or medium density urethane foam." *Perrine*, Col. 6, lns. 42-43. Thus, *Perrine* does not disclose a "rigid support layer", as recited in claim 1 as amended. Applicant requests withdrawal of this rejection of claim 1.

With regard to claim 2, *Perrine* refers to bottom pad 14 as being "made from a relatively soft layer of foam rubber, woven fabric, etc." *Perrine*, Col. 6, lns. 27-28. *Perrine* simply does not disclose "a rubber mat operably secured to said base element, wherein said rubber mat underlies said base element," as recited in amended claim 2, emphasis added.

Perrine discloses only the single layer of the bottom pad 14. Because the Examiner has used

the bottom pad 14 of *Perrine* to illustrate the base element (now “firm support layer”), see Office Action, page 2, this layer can not also illustrate the additional element of “a rubber mat operably secured to said base element, wherein said rubber mat underlies said base element,” as recited in amended claim 2, emphasis added. For purposes of clarity, the “base element” has been amended in these claims, and now Applicant claims a “firm support layer”. This combination of elements, as amended, is simply not disclosed in *Perrine*. *Perrine* does not disclose “a rubber mat operably secured to said firm support layer, wherein said rubber mat underlies said firm support layer”. Once again, the Examiner has pointed to the same element in *Perrine* to illustrate two elements in the present claim. Thus, *Perrine* does not disclose all of the elements of claim 2. Claim 2 is therefore patentable for at least that reason. Claims 4, 5, and 11 are patentable at least for the reason of their dependence on claim 2.

With regard to claim 4, *Perrine* can not disclose that “said rubber mat is secured to said base element by adhesives”, as recited in claim 4, because it does not disclose the separate elements of the rubber mat and the base element (now “firm support layer”), as discussed with regard to claim 2, above. Therefore, *Perrine* does not disclose that “said rubber mat is secured to said firm support layer by adhesives”, as recited in claim 4 as amended. Claim 4 is allowable for at least this additional reason.

With regard to claim 5, the Examiner has referred to the following passage in *Perrine*. “The top sheet 12 has a completely smooth, and very low-friction surface, is resilient and tends to lie flat at rest, yet is relatively compliant/non-rigid. It is made of a suitable type, size and thickness of sheet material such as plastic.” *Perrine*, Col. 5, Ins. 1-4. Yet the top sheet 12 of *Perrine* can not be used to illustrate the case “wherein said base element includes a substantially planar sheet of plastic”, as recited in claim 5. The top sheet 12 of *Perrine* has already been used by the Examiner to illustrate a different layer, the “Mark retaining means”.

See Office Action, page 2. Thus *Perrine* has failed to disclose the additional element of claim

5. Claim 5 is thus allowable for this additional reason.

Claim 11 is allowable for at least the reason of its dependence on claim 1.

Applicant respectfully requests withdrawal of this rejection with regard to claims 1, 2, 4, 5, and 11.

2. Claim Rejections -35 U.S.C. § 103(a): Obviousness

Claims 3 and 14

The Examiner has rejected Claims 3 and 14 “under 35 U.S.C. § 103(a) as being unpatentable over *Perrine*.” Office Action, page 3. Applicant has canceled claim 14. Applicant respectfully traverses this rejection with regard to claim 3 and requests reconsideration in light of the amendments to claims 2 and 3.

Perrine discloses that the “top sheet 12 and accompanying bottom pad 14 also can be thermally or adhesively bonded”. Col. 7, lns. 20-22. The Examiner has used the top sheet 12 as reference to the claimed element of the mark retaining means. See Office Action, page 2. Thus, the bonding of the top sheet 12 and the bottom pad 14 of *Perrine* cannot be used to illustrate the case “wherein said rubber mat is secured to said firm support layer by adhesives”, as recited in claim 3, as amended. Applicant contends that the Examiner has not pointed to bonding of the proper elements. Claim 3 is patentable for at least that reason, as well as for the reason of its dependence upon claim 2. Applicant respectfully requests withdrawal of this rejection.

Claims 6, 17, and 19

The Examiner has rejected claims 6, 17, and 19 “under 35 U.S.C. 103(a) as being unpatentable over *Perrine*.” Office Action, page 3. Claims 17 and 19 have been cancelled. Applicant respectfully traverses this rejection with regard to claim 6 and requests reconsideration in light of the amendments to claim 2 and 5 upon which claim 6 depends.

With regards to claim 6, the recited limitation "a sheet of polycarbonate plastic" is a further limitation of the earlier limitation "base element" in claim 5. The Examiner has earlier referred a "rigid support layer", as recited in claim 1 as amended to the base element as item 14 of *Perrine* on page 2 of the Office Action. In this rejection, the Examiner refers to "the top sheet (12)" with regards to this further limitation of the base element in claims 6. *Perrine* discloses that top sheet 12 "is relatively compliant/non-rigid." *Perrine*, Col. 5, ln. 3. In fact, *Perrine* discusses an upper limit for rigidity of the top sheet in the invention. See *Perrine*, Col. 6, lns. 9-13. Thus, not only does *Perrine* not disclose item 12 as "a sheet of polycarbonate plastic," as recited in claim 6, it specifically argues against the rigidity of such a modification. With regard to item 14, which the Examiner has pointed to as the base element (now "firm support layer) in the Office Action, *Perrine* discloses "a low or medium density urethane foam" (Col. 6, lns. 42-43). There is clearly no motivation to modify either of the layers in *Perrine* to "a sheet of polycarbonate plastic" as recited in claim 6. In fact, "the respective properties of the top sheet 12 and the bottom pad 14 together enable the whole mat 10 to function." *Perrine*, Col. 6, lns. 56-58. Thus, any modification of either of these layers of *Perrine* to become "a sheet of polycarbonate plastic," as recited in claim 6, is discouraged.

Applicants request withdrawal of this rejection.

Claims 7 and 18

The Examiner has rejected claims 7 and 18 "under 35 U.S.C. 103(a) as being unpatentable over *Perrine* in view of *Manheck* (US patent No. 3,754,764)." Office Action, page 4. Claim 18 has been cancelled. Applicant respectfully traverses this rejection with regard to claim 7.

Manheck is directed to "providing an effective means for capturing the exact impact point of a golf ball on the face of a club, thereby permitting an instant, visual evaluation of where the club hits the ball immediately after each swing." *Manheck*, Col. 1, lns. 40-45. This use contrasts with the invention of the present application in many ways. First, it involves the strike of the club to the ball, and not the strike of the club to the ground as in the present invention. Second, it involves a modification to the golf club. Third, any multiple use of the sheet 24 of *Manheck* will involve distorting earlier marks. These points stand in stark contrast to "a sheet of no carbon required paper having one or more simulated golf balls printed thereon", as recited in claim 7. Each of the simulated golf balls allows for the

recording of a different swing with only the slight relocation of the golfer's body to address a new position. Applicant asserts that these stark differences of end use and method of use discount any possibility of motivation to combine these references, as well as the fact that nowhere is taught or suggested a "sheet of no carbon required paper having one or more simulated golf balls printed thereon", as recited in claim 7, in either of the references. Applicant asserts that claim 7 is patentable for at least the foregoing reasons. Applicant requests withdrawal of this rejection.

Claim 9

The Examiner has rejected claim 9 "under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436)." Office Action, page 5. Applicant respectfully traverses this rejection with regard to claim 9.

Applicant asserts that claim 9 is patentable over the cited references for substantially the same reasons as the discussion of claim 7 above.

CONCLUSION

For the above reasons, Applicants respectfully request reconsideration and allowance of Claims 1-7, 9, and 11. Should the Examiner have any questions concerning this response, the Examiner is invited to call Michael Guth at (831) 462-8270.

In summary, Claims 1-7, 9 and 11-19 were pending in the application. Claims 1-7, 9, and 11-19 were rejected. This response amends Claims 1-5. For the above reasons, Applicants respectfully request reconsideration and allowance of claims 1-7, 9, and 11.

EXPRESS MAIL LABEL NO:

ER 444422860 US

Respectfully submitted,



Michael A. Guth
Attorney for Applicant
Reg. No. 45,983